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10/585,769

03/27/2007

Michael Nottley

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ARTHUR JACOB  
25 EAST SALEM STREET  
P.O. BOX 686  
HACKENSACK, NJ 07602

EXAMINER

MENDIRATTA, VISHU K

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |   |  |
|------------------------------|--|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/585,769   | <b>Applicant(s)</b><br>NOTTLEY, MICHAEL |  |
|                              | <b>Examiner</b><br>Vishu K. Mendiratta | <b>Art Unit</b><br>3711                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 1/12/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 1 limitations 'wherein second die and third die are relatively configured.....third die.'" is new matter and was not presented in the disclosure to demonstrate either in drawing or in specification as originally presented. Claim 28 limitations 'an adjunctive die (making a total of four dice)' is new matter and was not presented in the disclosure to demonstrate either in drawing or in specification as originally presented.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

2. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Hokanson (5090706).

Claim 1, 28: Hokanson teaches a game board (Fig.1) having a first, second and third die (Fig. 10-13), a game path (12), start and finish spaces (16, 17a), a plurality of squares (12a), the squares being identified by different colored shapes (12b) that can be treated as match squares (3:45-47) and dice configured to tend to predictably win the competition (abstract). It can be clearly seen from the die faces that a die configured to have higher number on face will tend to yield higher score (4:38-42). Examiner also

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takes the position that inherently a conventional die can yield higher score as result of chance.

Claim 28: Hokanson teaches a game board (Fig.1) having a first, second, third and fourth die (Fig. 10-13), a game path (12), start and finish spaces (16, 17a), a plurality of squares (12a), the squares being identified by different colored shapes (12b) that can be treated as match squares (3:45-47) and dice configured to tend to predictably win the competition (abstract). It can be clearly seen from the die faces that a die configured to have higher number on face will tend to yield higher score (4:38-42). Examiner also takes the position that inherently a conventional die can yield higher score as result of chance. Rules for playing and intended use limitations do not further limit the claimed apparatus.

Claim 2: The relative positions of game pieces in Hokanson board during movement on game path can be treated as a tabulation of relative positions due to the competition (3:45-47). Examiner also takes the position that limitations do not positively provide a structure to further limit the claimed apparatus. Limitation "tabulation" is an action by a player and not a structure.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1, 3-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Caggiano in view of Hokanson.

Claim 1: Caggiano teaches a board game having a board (12), a path with start space (large square at upper left corner), an end space (large square at the lower left corner), tokens (18), dice (14) and a plurality of squares (3:44-56) that can be treated as

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match squares. Caggiano inherently teaches the subject matter of the match being sports (3:42-43) and the players competing either individually or in teams (3:56-59).

Caggiano teaches all limitations except that it does not teach three dice and a pair of dice configured to yield higher score in a match

Hokanson teaches a game board providing three dice including a pair of dice tending to resulting a higher score in a match. It can be clearly seen from the die faces that a die configured to have higher number on face will tend to yield higher score (4:38-42).

Examiner also takes the position that inherently a conventional die can yield higher score as result of chance.

Variations are well known in the art area of board game s and in order to achieve a predictable score it would have been obvious to configure a set of dice to result in a higher score upon a match. One of ordinary skills in art at the time the invention was made would have suggested configuring a pair of dice to predict a higher score in a match.

Claim 3: Caggiano teaches a shape of path looping as in the shape of cups at least three places. The limitations "whereat....match dice" are rules for playing and do not further limit the apparatus in the claim. However shapes are a matter of aesthetic choice of game makers and in order to attract players it would have been obvious to configure any attractive shapes on squares.

Claim 4: The limitations are rules for playing and do not further limit the apparatus in the claim.

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Claim 5: Caggiano teaches a die set 14. Intended use limitations and rules do not further limit the claimed apparatus.

Claims 6, 7, 8: Caggiano spaces marked with letters can be used for any intended use including as hazard space and cards (16) that can be used for any intended use including as several sets of hazard cards.

4. Claims 1, 2, 25-27, 28-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce in view of Hokanson.

Claims 1, 28, 29, 30, 31: Pierce teaches a board game having a board (Fig.1), a path with start space (1), an end space (33), tokens (abstract), dice inherently having numbers (2:32-42) and a plurality of squares (3:13-17) that can be treated as match squares. Pierce inherently teaches the subject matter of the match being sports (Football) and the players competing either individually or in teams (Fig.8).

Pierce teaches all limitations except that it does not teach three dice and a pair of dice configured to yield higher score in a match

Hokanson teaches a game board providing three dice including a pair of dice tending to resulting a higher score in a match. It can be clearly seen from the die faces that a die configured to have higher number on face will tend to yield higher score (4:38-42).

Examiner also takes the position that inherently a conventional die can yield higher score as result of chance.

Variations are well known in the art area of board game s and in order to achieve a predictable score it would have been obvious to configure a set of dice to result in a higher score upon a match. One of ordinary skills in art at the time the invention was

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made would have suggested configuring a pair of dice to predict a higher score in a match.

Claims 32-34: Limitations are intended use and do not further limit the apparatus

Claims 2, 26, 27: Pierce teaches a tabulation means as in score sheet with means for adjusting position of teams (as in recording means in Fig.9) for recording any information needed to maintain the game play.

Claim 25: Pierce teaches spaces numbered 1 through 72.

5. Claim 9-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce and Hokanson.

Pierce teaches all limitations except that it does not expressly teach providing game money. Pierce however teaches using money to complete (1:25-40) their team and to participate in sports. In order to make the game team competitive, it would have been obvious to acquire players and complete teams. One of ordinary skills in art at the time the invention was made would have suggested providing money in the game for each participant.

Claims 10-13, 16-21: Paying various amounts to players, it treated as rules for play and do not further limit the game apparatus. Intended use limitations also do not further limit the claimed apparatus.

Claims 14, 15: Pierce cards (Fig.4-7) can be used for any intended use including as several sets of star cards.

6. Claims 22-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce and Hokanson, further in view of Romaniello.

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Claim 22: Pierce and Hokanson teach all limitations except that it does not teach providing emblems for teams. Romaniello teaches providing emblems (3:13-15) for teams. In order to properly simulate a sports match, it would have been obvious to provide items to make the game real like. One of ordinary skills in art at the time the invention was made would have suggested providing emblems for teams.

Claims 23, 24: Limitations are intended use/rules and do not further limit the claimed apparatus.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vishu K Mendiratta/  
Primary Examiner, Art Unit 3711

Vishu K Mendiratta  
Primary Examiner  
Art Unit 3711